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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,894	04/25/2001	Yasuhiro Kujirai	862.C2210	4470
5514	7590	09/22/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RAHIMI, IRAJ A	
			ART UNIT	PAPER NUMBER
			2622	
DATE MAILED: 09/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/840,894	KUJIRAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	(Iraj) Alan Rahimi	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 April 2001.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5 IDS (6/28/05).
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-15 in the reply filed on June 27, 2005 is acknowledged. Claims 16-44 were withdrawn from consideration. Applicant needs to cancel claims 16-44 in the next paper.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.”

Claim 12, while defining computer program, does not define a “computer-readable medium” and is thus non-statutory for that reasons. A computer program can range from paper

on which the program is written, to a program simply contemplated and memorized by a person.

The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-5, 6, 9, 11-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Motegi Akihiko (Japanese publication number 09-244828).

Regarding claim 1, Akihiko discloses a print control apparatus for performing user authentication processing in print processing, characterized by comprising:

a job combination unit for combining a plurality of print jobs into a single combined print job (paragraph 24); and

a request unit for issuing a request to an authentication server for getting a permission to print the single print job combined by said job combination unit (paragraph 21),

wherein if the authentication request succeeds, the combined print job transmitted  
(Paragraph 22-23).

Regarding claim 3, Akihiko discloses the apparatus according to claim 1, characterized  
that the authentication server and the print control apparatus are connected a communication  
network (paragraph 15-16), and

the communication network is connected to a plurality of printers (paragraph 15).

Regarding claim 4, Akihiko discloses the apparatus according to claim 1, characterized  
that the authentication server is provided by a printer (paragraph 21).

Regarding claim 5, Akihiko discloses the apparatus according to claim 1, characterized  
in that the print control apparatus includes a host computer (host computer 1).

Regarding claims 6, 9, 12 and 13, Arguments analogous to those presented for claim 1,  
are presented.

Regarding claims 7, 10, and 14, Arguments analogous to those presented for claim 2, are  
presented.

Regarding claims 8, 11 and 15, arguments analogous to those presented for claim 4, are  
presented.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 7, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akihiko (Japanese patent publication 09-244828) in view of Miyamoto Takeshi (Japanese patent publication 07-073128).

Regarding claim 2, Akihiko does not disclose the apparatus according to claim 1, characterized by further comprising a counting unit for counting a print amount including the number of prints to be printed by the combined print job and transmitting information about the counted print amount to a counting server.

Takeshi discloses this limitation in the abstract.

Akihiko and Takeshi are combinable because they are from the same field of endeavor that is network-printing system.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to count the sheets of the combined print job.

The suggestion/motivation for doing so would have been for the printer to track the inventory of used consumables for reporting to the operator/user for timely replenishment.

Therefore, it would have been obvious to combine Akihiko and Takeshi to obtain the invention as specified in claim 2.

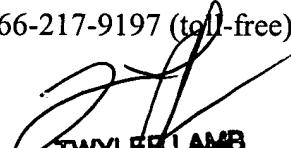
***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 571-272-7411. The examiner can normally be reached on Mon.-Fri. 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Alan Rahimi  
September 16, 2005

  
TWYLER LAMB  
PRIMARY EXAMINER